

OCT. 12. 2005 4:23PM

TL&A 512-327-5452

RECEIVED
CENTRAL FAX CENTER

NO. 3219 P. 4

Doc Code: AP.PRE.REQ

OCT 12 2005

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>10/12/2005</u></p> <p>Signature <u>MA Andre</u></p> <p>Typed or printed name <u>Laura H. Andre</u></p>		Application Number	Filed
		09/497,773	02/03/2000
		First Named Inventor	
		Jerry E. Pierce	
		Art Unit	Examiner
		3627	CUFF, Michael A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>50,776</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of <u>5</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OCT 12 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jerry E. Pierce et al.

Title: METHOD AND SYSTEM FOR OPTIMIZING MARKET ACCESSIBILITY VIA AN
ELECTRONIC NETWORK

App. No.: 09/497,773

Filed: 02/03/2000

Examiner: CUFF, Michael A.

Group Art Unit: 3627

Atty. Dkt. No.: 1007-0001

Confirmation No.: 7892

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Office Action dated August 1, 2005 (hereinafter, "the Office Action"), Applicants have filed a Notice of Appeal and respectfully request review of the Office Action in view of the following reasons.

In response to a Final Office Action dated March 30, 2004, Applicants filed a Notice of Appeal. Subsequently, the Examiner issued a second Final Office Action dated July 7, 2004. Applicants filed an Appeal Brief on August 23, 2004 and an Amended Appeal Brief on December 21, 2004 to correct informalities. No notice or communication relating to a review by the Board of Appeals was received. Instead, a further Office Action was sent March 31, 2005, citing Sony websites, allowing claims 19-23, 29-30, and 35-38, and indicating that, if rewritten, claim 17 would be allowable. Applicants submitted an Amendment on May 16, 2005, complying with the Examiner's requirements and placing the Application in a condition for allowance. However, the Examiner issued a further Office Action dated August 1, 2005, citing art (Sony websites) that to a large extent appear the same as previously cited and likely no more relevant than the Sony website art previously reviewed. The additional Sony website certainly

could have been cited along with the other Sony websites cited in the March 31, 2005 Office Action with allowed claims. The August 1, 2005 Office Action also rejects the claims that were previously indicated as allowable. Thus, Applicants again file for Appeal to have this application allowed.

Claims 17-25, 30 and 35-38 are patentable over www.sonymusical.com, www.sonymusic.com, www.sonymusic.com, www.sonymusic.com, and www.thestore.sonymusic.com.

The independent claims 17, 19, and 23 are directed to methods that include establishing a first website, establishing a second website, and establishing a third website. Each of the websites has a domain name following a particular naming convention and each of the websites includes a link to each of the other websites.

The Examiner has turned to www.sonymusical.com (5/8/1999), www.sonymusic.com (5/7/1999), www.sonymusic.com (4/28/1999), and www.thestore.sonymusic.com (2/3/1999). It should be noted that thestore.sonymusic.com and www.sonymusic.com are in fact the same website (sonymusic.com) following the naming convention of the present application. As such, sonymusic.com represents the central website or one of the three websites, but cannot represent both. Herein, sonymusic.com is interpreted as a central website as is implied by the relationship of the subject matter of the cited websites.

While the Examiner asserts that sonymusical.com and sonymusic.com as of their respective dates may have had a link to sonymusic.com, the Examiner admits that these cited websites were not each linked to by each other. For example, sonymusic.com on the date cited did not include a link to sonymusical.com, sonymusical.com on the date cited did not include a link to sonymusic.com, and sonymusic.com on the cited date did not include a link to sonymusic.com.

Accordingly, the Examiner has turned to Official Notice that such links were well known. Regarding Official Notice, expertise may provide sufficient support for conclusions only as to peripheral issues (MPEP 2144.03 (A)). In part, at issue is whether establishing a group of at least three websites following a particular naming convention and wherein each of the websites includes a link to each of the other websites, as claimed, would have been obvious at the time of

the invention. As such, the Examiner has relied on improper Official Notice and Applicants respectfully traverse the Official Notice.

However, assuming *arguendo* that a reference is available showing "reciprocal links" in the manner asserted by the Examiner, combination of such a reference with the cited websites would fail to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the references or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicants' disclosure. (MPEP 2143.01).

While the Examiner may argue that it was obvious at the time of the invention to provide a reciprocal link between a central website (i.e., sonymusic.com) and another website (i.e., sonyclassical.com) that links to the central website, the Examiner has failed to establish a motivation for providing links between websites other than the central website (e.g., between sonynashville.com and sonyclassical.com) which follow the claimed naming convention. Using an example from the present specification, the Examiner has failed to provide an objective reason why it would be obvious to provide a link, for example, between www.refrigeratorworld.com and www.hotdogworld.com. Instead, the Examiner appears to be relying on impermissible hindsight. Absent the Applicants' own disclosure, there is no motivation or suggestion to establish websites following the particular naming convention and wherein each website includes a link to each of the other websites, as claimed.

In addition, Applicants have previously submitted a Declaration and supporting documents providing objective evidence and secondary considerations of non-obviousness including evidence of long felt need, unexpected results, and commercial success. The Declaration signed by Jerry E. Pierce dated June 3, 2003 and supporting documents were provided in an Amendment filed June 18, 2003. The evidence shows a long felt need as expressed by a news article describing the failure of banner advertising. In addition, the evidence presented shows unexpected results and commercial success attributed to a website configured in accordance with an embodiment of the claimed invention.

Further, Applicants respectfully traverse the Official Notice that it would have been obvious to market restaurant equipment in the context of the claimed methods.

As such, Applicants respectfully request withdrawal of the 35 U.S.C. 103(a) rejection of claims 17-25, 30 and 35-38. Applicants respectfully submit that the present application is in condition for allowance. Accordingly, the PTO is requested to issue a Notice of Allowance for all pending claims.

Since the rejection rests on clear factual and legal errors, Applicants respectfully request the withdrawal of the rejection and the allowance of the present application without the need for a long and costly appeal.

Applicants have previously filed a Notice of Appeal and Appeal Brief with respect to the present application, resulting in withdrawal of the rejection by the Examiner prior to review by the Board. As such, Applicants do not believe that additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,



John R. Schell, Reg. No. 50,776
Agent for Applicant
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5452 (fax)

Date

10-11-05